

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 1, 3 through 7, and 9 have been amended. Claim 8 has been cancelled. Claims 5 and 6 are listed as "currently amended" although these claims have been withdrawn subject to an earlier restriction requirement. As discussed later, it is respectfully requested that in view of the present amendments, the restriction requirement for claims 5 and 6 be lifted. Claims 1, 3, 4, 7 and 9 are pending and under consideration.

GROUND FOR ENTRY OF THIS RESPONSE PURSUANT TO 37 C.F.R. 1.116

The Applicants respectfully request entry of this Rule 116 Response because it is believed that the amendments and arguments put forward place these claims in condition for allowance. These amendments and arguments were not earlier presented because the Applicants believed in good faith that the claims as recited in their previous form were allowable over the previously cited prior art and complied with 35 USC 112. The claims as amended address and resolve the newly raised 112 rejection.

CLAIM REJECTIONS -- 112

Claims 1, 3, 4 and 7-9 were rejected under 35 USC 112, second paragraph, as being indefinite.

Claim 8 has been cancelled. Claims 1, 3, 4, 7 and 9 have been amended to recite that the present invention is directed to a wheel support bearing assembly rather than a protective cap. It is respectfully submitted that this shift is permissible under MPEP 2172 and it is further submitted that claims 1, 3, 4, 7 and 9 are definite in their present form.

Withdrawal of the foregoing rejection is requested.

CLAIM REJECTIONS -- 102

Claims 1, 3, 4 and 7-9 were rejected under 35 USC 102(b) as being anticipated by Brown (US 3,148,798) (hereinafter "Brown").

Claim 8 was rejected under 35 USC 102(b) as being anticipated by Ohtsuki et al. (US 6,692,153) (hereinafter "Ohtsuki").

Claim 9 was rejected under 35 USC 102(b) as being anticipated by Message et al. (US 5,873,658) (hereinafter "Message").

Regarding claims 1, 3, 4 and 7-9 which were rejected under 35 USC 102(b) based on Brown, Brown only discusses a protective closure. Claim 8 has been cancelled. In their present form claims 1, 3, 4, 7 and 9 recite a wheel support bearing assembly and therefore are not anticipated by the protective closure of Brown.

Regarding claim 8, which was additionally rejected under 35 USC 102(b) based on Ohtsuki, claim 8 has been cancelled.

Regarding claim 9, which was additionally rejected under 35 USC 102(b) based on Message, claim 9 recites an engagement wall which is removably engaged with the rotatable member. By contrast, Message discusses a cap 15 which includes a cylindrical portion 15a surrounding the sensor carrier block 11 and a portion 16a of the outer cylindrical surface 16 of the stationary race 1. See Message, 3:46-3:56 and Figures 1-3 and 6. By contrast, claim 9 recites that the engagement wall is removably engaged with the rotatable member, not a stationary race.

Withdrawal of the foregoing rejections is requested.

CLAIM REJECTIONS – 103

Claims 1, 3, 4 and 7 were rejected under 35 USC 103(a) as being unpatentable over Schottodorf et al. (WO 01/25799) (hereinafter "Schottodorf") in view of Brown.

Claims 1, 3 and 4

Amended claim 1 recites: "...an engagement wall integral with the annular cover-up portion and capable of being removably engaged with an inner peripheral surface of one end of an axial bore of the inner member..." As noted in the Office Action on pages 5 and 6, Schottodorf does not discuss an engagement wall engaged with an inner peripheral surface of an axial bore. The Office Action instead relies on Brown to supply this feature of claim 1. Brown describes a protective closure in the form of a plug to enclose the end of a projecting part, such as a pipe or a tubing end.

It is well settled that an invention is not obvious when prior art elements are from unrelated or nonanalogous fields. See, for example, *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d

1443 (Fed. Cir. 1992) ("Simplicity is not inimical to patentability"). Claim 1 and the primary reference Schottodorf both relate to rolling bearing units. Brown, however, relates to a pipe plug having a handle and is therefore nonanalogous to both claim 1 and Schottodorf. Further, the arrangement of Schottodorf does not contemplate the plug arrangement of Brown. For the foregoing reasons, it is respectfully submitted that the combination of Shchottodorf and Brown is improper and that claim 1 is not obvious over the cited prior art.

Claims 3 and 4 depend on claim 1 and are therefore believed to be allowable for the foregoing reasons.

Withdrawal of the foregoing rejection is requested.

Claim 7

Amended claim 7 recites: "...an engagement wall, integral with the annular cover-up portion, and removably engaged with the rotatable member, whereby the protective cap is removably mounted on the wheel support bearing assembly." The Office Action relies on Brown to supply this feature of claim 7. However, it is well settled that an invention is not obvious when prior art elements are from unrelated or nonanalogous fields. Claim 7 and the primary reference Schottodorf both relate to rolling bearing units. Brown, however, relates to a pipe plug having a handle and is therefore nonanalogous to both claim 7 and Schottodorf. Further, the arrangement of Schottodorf does not contemplate the plug arrangement of Brown. For the foregoing reasons, it is respectfully submitted that the combination of Shchottodorf and Brown is improper and that claim 7 is not obvious over the cited prior art.

Withdrawal of the foregoing rejection is requested.

WITHDRAWN CLAIMS

It is respectfully submitted that withdrawn dependent claims 5 and 6 be entered and considered. In view of the amendment to the base claim of claims 5 and 6, it is believed that the subject matter of claims 5 and 6 would not longer be found to be in a patentably distinct species.

CONCLUSION

There being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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